

The opinion in support of the decision being  
entered today is not binding precedent of the Board.

Paper ~~123~~ 4

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Filed: May 9, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

SMITHKLINE BEECHAM CORPORATION

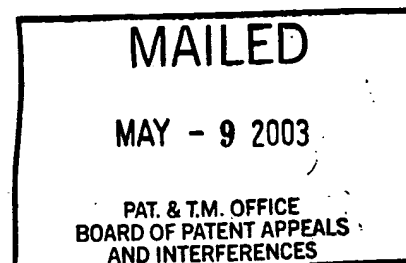
Junior Party  
U.S. Patent 5,637,310  
U.S. Patent 5,496,556

v.

GARY H. RASMUSSEN and GLENN F. REYNOLDS

Senior Party  
Application 08/460,296

Patent Interference No. 104,646



ORDER REDECLARING INTERFERENCE  
(37 CFR § 1.611)

The reissue applications of U.S. Patents 5,637,310 ("SKB '310") and 5,496,556 ("SKB '556") have been assigned Serial Nos. 09/964,383 ("SKB '383") and 09/984,083 ("SKB '083"), respectively. In view of the decision on remaining preliminary and miscellaneous motions (Paper 122) and the order dismissing U.S. Patent 5,300,294

from interference 104,646 (Paper 38), it is

ORDERED that the interference is redeclared as follows:

1. SKB is additionally involved in this interference on the basis of reissue application 09/964,383 ("SKB '383") of U.S. 5,367,310 (RANDALL K. JOHNSON).

Reissue application SKB '383 was filed September 28, 2001.

2. SKB is additionally involved in this interference on the basis of reissue application 09/984,083 ("SKB '083") of U.S. Patent 5,496,556 (RANDALL K. JOHNSON).

3. The following new Count 2 is substituted for Count 1<sup>1</sup> (material deleted from Count 1 is shown in strikeout and material added to Count 1 shown in **bold**):

Count 2

~~The method of claim 1 of the '310 patent wherein the steroid 5 $\alpha$ -reductase inhibitor compound is 17 $\beta$ -(N-t-butylcarboxamide)-5- $\alpha$ -androst-1-ene-4-aza-3-one.~~

~~or~~

~~The method of claim 1 of the '556 patent wherein the steroid 5 $\alpha$ -reductase inhibitor compound is 17 $\beta$ -(N-t-butylcarboxamide)-5- $\alpha$ -androst-1-ene-4-aza-3-one.~~

~~or~~

~~The method of claim 1 of the '294 patent wherein the steroid 5 $\alpha$ -reductase inhibitor compound is 17 $\beta$ -(N-t-butylcarboxamide)-5- $\alpha$ -androst-1-ene-4-aza-3-one.~~

~~or~~

The method of claim 4 of the Rasmusson '296 08/460,296 application wherein

<sup>1</sup> See Paper 1, p. 6 and Paper 38.

the animal is human:

or

**The method of claim 3 of the SKB 09/964,383 application**

or

**The method of claim 2 of the SKB 09/984,083 application.**

A clean copy of Count 2 reads as follows:

Count 2

The method of claim 4 of the Rasmusson 08/460,296 application wherein the animal is human

or

The method of claim 3 of the SKB 09/964,383 application

or

The method of claim 2 of the SKB 09/984,083 application.

4. The claims of the parties are:

Rasmusson '296	1-8
SKB '310	1-2 <sup>2</sup>
SKB '556	1 <sup>3</sup>
SKB '383	1-3 <sup>4</sup>
SKB '083	1-2 <sup>5</sup>

5. The claims of the parties that correspond to Count 2 are:

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<sup>2</sup> SKB '310 claim 1 is unpatentable.

<sup>3</sup> SKB '556 claim 1 is unpatentable.

<sup>4</sup> SKB '383 claim 1 is unpatentable.

<sup>5</sup> SKB '083 claim 1 is unpatentable.

Rasmusson '296	1-8
SKB '310	1
SKB '556	1
SKB '383	1, 3
SKB '083	1-2

6. The claims of the parties that do not correspond to Count 2, and therefore are not involved in the interference on the issue of priority, are:

Rasmusson '296	none
SKB '310	2
SKB '556	none
SKB '383	2
SKB '083	none

7. Rasmusson '296, filed June 2, 1995, is accorded NO benefit for the purpose of priority as to Count 2.

8. SKB '310 is accorded benefit for the purpose of priority as to Count 2 of

- (1) U.S. application 08/170,481, filed December 20, 1993 and
- (2) U.S. application 07/544,709, filed June 27, 1990.

9. SKB '556 is accorded benefit for the purpose of priority as to Count 2 of

- (1) U.S. application 07/544,709, filed June 27, 1990.

10. SKB '383 is accorded benefit for the purpose of priority as to Count 2 of

- (1) U.S. application 08/452,675, filed May 30, 1995,
- (2) U.S. application 08/170,481, filed December 20, 1993 and
- (3) U.S. application 07/544,709, filed June 27, 1990.

11. SKB '083 is accorded benefit for the purpose of priority as to Count 2 of

- (1) U.S. application 08/170,481, filed December 20, 1993 and
- (2) U.S. application 07/544,709, filed June 27, 1990.

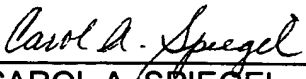
12. Since the priority benefit date of SKB (June 27, 1990) is earlier than the priority benefit date of Rasmusson June 25, 1995 filing date, the order of the parties is reversed thereby making SKB senior party.

FURTHER ORDERED that, to the extent applicable, the procedures set forth in the attached STANDING ORDER are in effect for the remainder of the interference.

FURTHER ORDERED that the caption of papers filed in the remainder of the interference shall be captioned as set forth in the appendix to this ORDER.

FURTHER ORDERED that within **14 (fourteen) days** of the date of this ORDER, each party shall either: (1) file a statement indicating that it is relying on the preliminary statement it has already filed in the interference for the subject matter of Count 2 or (2) file a new preliminary statement for the subject matter of Count 2.

FURTHER ORDERED that a conference call is scheduled for **May 23, 2003 at 10:00 a.m.** to set times for taking action during the priority phase of the interference. The call will be initiated by the PTO.

  
CAROL A. SPIEGEL,  
Administrative Patent Judge

Date: May 9, 2003  
Arlington, VA

Enc: Copy of STANDING ORDER

APPENDIX

Paper No. \_\_\_\_\_

Filed on behalf of:  
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UNITED STATES PATENT AND TRADEMARK OFFICE  
(Administrative Patent Judge Carol A. Spiegel)

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BEFORE THE BOARD OF PATENT APPEALS  
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GARY H. RASMUSSEN and GLENN F. REYNOLDS

Junior Party,  
Application 08/460,296

v.

SMITHKLINE BEECHAM CORPORATION

Senior Party,  
U.S. Patent 5,637,310  
U.S. Patent 5,496,556  
Reissue Application 09/964,383  
Reissue Application 09/984,083

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Patent Interference 104,646

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TITLE OF PAPER

104,646  
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